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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,352	04/15/2004	Roy Schoenberg	66729/P028US/10613659	8650

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EXAMINER

KOPPIKAR, VIVEK D

ART UNIT	PAPER NUMBER
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3686

MAIL DATE	DELIVERY MODE
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10/08/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/825,352	Applicant(s) SCHOENBERG, ROY	
	Examiner VIVEK D. KOPPIKAR	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/30/04 & 12/18/06</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Status of the Application

1. Claims 1-35 have been examined in this application. This communication is the first action on the merits. The Information Disclosure Statements (IDS) filed on September 30, 2004 and December 18, 2006 have also been acknowledged.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-17 and 35 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims are method claims but the claims are not tied to a statutory class of patentable subject matter because they do not recite a device (e.g. a computer) for carrying out the method. The Office recommends amending the claims so that they will recite a device (e.g. a computer) which is used in carrying out the method. The Office would like to remind applicants, however, that any amendment(s) to the claims must have support in the specification as it was originally filed.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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5. Claims 1-8, 11-14, 17-25, 28-31 and 34-35 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent Number 7,304,852 to Kerr, II et al.

(A) As per claim 1, Kerr teaches a rule processing computer-based method (Kerr: Abstract)comprising:

defining a target group of patients chosen from a group of existing patients (Kerr; Col. 9, Ln. 1-30);

defining an action to be taken concerning one or more patients within the target group of patients (Kerr: Col. 1, Ln. 9-30); and

scheduling an execution time for the action (Kerr: Col. 1, Ln. 9-30).

(B) As per claim 2, Kerr teaches defining a target group of patients includes processing the medical records of the existing patients to determine which of the medical records define the existence of a selected condition (Kerr; Col. 9, Ln. 1-30).

(C) As per claim 3, Kerr teaches that the selected condition concerns a medical condition of a patient (Kerr; Col. 9, Ln. 1-30).

(D) As per claim 4, Kerr teaches that the selected condition concerns a physical criteria of a patient (Kerr: Col. 9, Ln. 1-30).

(E) As per claims 5-6, Kerr teaches that the selected condition teaches a habit of a patient or activity of a patient (Kerr: col. 1, Ln. 12-31).

(F) As per claim 7, in Kerr the step of defining an action includes one or more of:

posting a HTML link for a patient;

posting a message for a patient;

providing a tool to a patient;

transmitting an email to a patient;

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updating a patient's medical record;
transmitting a pop-up message to a patient;
recommending that a patient join a discussion board;
providing a patient with medical information;
providing a medical report to a patient;
providing a medical report to a third party;

executing a program; and
notifying a third party (Kerr: Col. 2, Ln. 58-Col. 3, Ln. 3 and Col. 9, Ln. 1-30).

(G) As per claim 8, Kerr teaches that the step of scheduling an execution time includes specifying a single, non-recurring, execution time (Kerr: Col. 2, Ln. 58-Col. 3, Ln. 3).

(H) As per claim 11, Kerr teaches the step of executing the action concerning the one or more patients within the target group of patients on or after the execution time (Kerr: Col. 2, Ln. 58-Col. 3, Ln. 3 and Col. 9, Ln. 1-30).

(I) As per claims 12-14 and 17, these claims are substantially similar to Claims 1-8 and 11 and are therefore rejected on the same basis as these claims, which is set forth above.

(K) As per claims 18-25 and 28, these claims are substantially similar to Claims 1-8 and 11, above, and are therefore rejected on the same basis, which is set forth above.

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(L) As per claims 29-31 and 34-35, these claims are substantially similar to Claims 1-8 and 11, above, and are therefore rejected on the same basis, which is set forth above.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kerr, as applied to Claim 1, and in further view of Official Notice.

(A) As per claims 9-10, Kerr does not teach that the step of scheduling an execution time includes specifying a plurality of non-recurring execution times nor does Kerr teach that the step of scheduling an execution time includes specifying a recurring execution time, however, the Office takes Official Notice that this limitation is well known in the prior art, and, at the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified Kerr with the above aforementioned teachings with the motivation of having a means of varying the number of times that the notification system notified the patient as well as having a means of specifying the duration between execution times (of the patient notification system in Kerr).

(B) As per claims 15-16, 26-27 and 32-33, these claims are substantially similar to Claims 9 and 10 and are therefore rejected on the same basis, as is set forth above.

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Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivek Koppikar, whose telephone number is (571) 272-5109. The examiner can normally be reached from Monday to Friday between 8 AM and 4:30 PM.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Jerry O'Connor, can be reached at (571) 272-6787. The fax telephone numbers for this group are either (571) 273-8300 or (703) 872-9326 (for official communications including After Final communications labeled "Box AF").

Another resource that is available to applicants is the Patent Application Information Retrieval (PAIR). Information regarding the status of an application can be obtained from the (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAX. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please feel free to contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely,

/Vivek D Koppikar/

Examiner, Art Unit 3686

10/10/2008

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